



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re. Appln.: R. Johannes Luyken, et al.
Serial No.: 10/600,750
Filed: June 19, 2003
For: CIRCUIT ELEMENT HAVING A FIRST LAYER COMPOSED OF AN ELECTRICALLY INSULATING SUBSTRATE MATERIAL, A METHOD FOR PRODUCING A CIRCUIT ELEMENT, BISPYRIDINIUM COMPOUNDS AND THEIR USE IN CIRCUIT ELEMENTS
Attorney: Jeffrey R. Stone
Attorney
Docket No.: 32226.65
Confirmation No.: 5993
Additional Fees: Charge to Deposit Account 023732

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 CFR 1.47 TO ACCEPT APPLICATION
WITHOUT SIGNATURE OF ONE INVENTOR AND STATEMENT OF FACTS**

Sir:

In the above-entitled patent application, Applicants petition to have this application accepted without the signature of one joint inventor, Jon Preece.

Attached hereto is a copy of two letters from Jon Preece dated July 30, 2003 and August 5, 2003 to Herr Eric-Michael Dokter of Viering, Jentschura & Partner, counsel for Infineon Technologies AG (Assignee), and a responsive letter from Mr. Dokter to Mr. Preece dated August 13, 2003.

Applicant respectfully requests that this application be accepted without the signature of Jon Preece.

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this document is being deposited with the United States Postal Service as Express Mail, receipt no. EV 190456567 US in an envelope addressed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

By Katy Sathre
Date November 13, 2003

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Enclosed with this Petition is our Response to the Notice to File Missing Parts of Nonprovisional Application, Petition Fee and surcharge. Should any further fees be due, you are authorized to charge Deposit Account No. 023732.

Respectfully submitted,

Dated: 11/13/03

By 
Jeffrey R. Stone (Reg. No. 47,976)
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80 South Eighth Street
Minneapolis, Minnesota 55402
Telephone: (612) 977-8560



Dr Jon A Preece
Flat 4, 55 Anderton Park Road
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E: j.a.preece@bham.ac.uk

30th July 2003

Herr Eric-Michael Dokter
Viering, Jentschura & Partner
Schwepnitzer Str. 2
01907 Dresden
Deutschland

Dear Herr Dokter

Re: Declaration of 'Power of Attorney' and 'Assignment' to Infineon Technologies

P26398 (21905 DE)

Thank you for your letter dated 8th July 2003. I apologise for not replying sooner, but I have just returned from my two weeks annual holiday on Saturday.

Having consulted with my legal representative this morning, I am happy to sign the above documents subject to a fee.

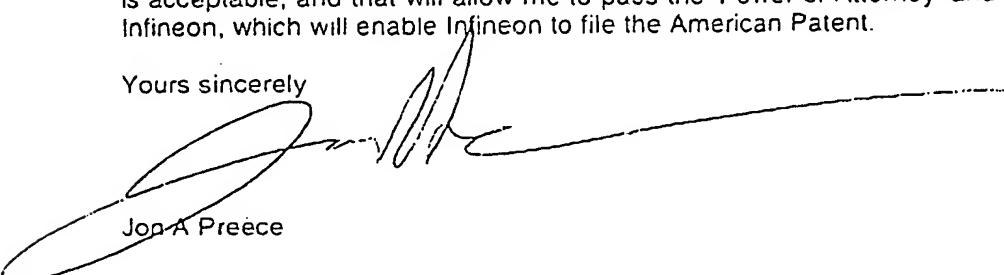
My legal representative has advised me that the fee should be considerably larger than that of the original 600 DM that Infineon paid to me, in which I had to waive all rights to any income streams that developed from the European Patent Application.

My legal representative has advised me that I was very naive to accept the 600 DM as this did not even cover my time as a consultant, let alone my intellectual input, that has been nurtured over a 17 year scientific career, which generated the idea for the patent.

Additionally, he advised me that I was also very naive to discuss the idea with Infineon without some form of *non-disclosure agreement*. However, I acted in good faith when I did discuss the idea with Infineon.

I look forward to hearing from you in the near future, in order that we can negotiate a fee that is acceptable, and that will allow me to pass the 'Power of Attorney' and 'Assignment' over to Infineon, which will enable Infineon to file the American Patent.

Yours sincerely



Jon A Preece



Dr Jon A Preece
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UK

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5th Aug 2003

Herr Eric-Michael Dokter
Viering, Jentschura & Partner
Schwepnitzer Str. 2
01907 Dresden
Deutschland

Dear Herr Dokter

Re: *Declaration of 'Power of Attorney' and 'Assignment' to Infineon Technologies*
P26398 (21905 DE)

Included with this letter is a letter that I sent to you on the 30th July 2003 as an attachment in an email.

Having not received a reply to this first letter or acknowledgement of the receipt of the letter, I am writing this follow-up letter.

If I do not receive a reply by Monday 11th August 2003 to my letter of 30th July 2003 then my legal representative will be writing to you, and a copy will be sent to the American Patent Office, detailing that I am not giving 'Power of Attorney' and 'Assignment' to Infineon Technologies to act on my behalf with respect to filing the patent in America, of which I am a applicant on the European Patent.

I sincerely hope that this matter can be resolved in a timely and satisfactory manner for all parties concerned.

Yours sincerely

Jon A Preece



Jon Preece
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Patentanwälte - European Patent Attorneys
European Trade Mark Attorneys
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Alexander Schlee, Dipl.-Ing. **
Dr. Matthias Nobbe, Dipl.-Chem. ***
Adam Bogsch, Dipl.-Ing. **
Armin Kühn, Dipl.-Ing. **
Eric Dokter, Dipl.-Ing. ***
Dr. Wolfram Schiweck, Dipl.-Ing. (Chem.) **
Dr. Hartmut Frank, Dipl.-Phys. ***

Rechtsanwälte - Attorneys At Law
Dr. Wolfgang Festl-Wietek *
Pascal Rath *

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Viering, Jentschura & Partner
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Ihr Zeichen/Your ref.: Unser Zeichen/Our file: Bearbeiter: Datum/Date:
P26398 Dok 13.08.2003

Patent Application in the USA
Declaration of "Power of Attorney" and "Assignment" to Infineon Technologies AG
P26398 (P21905 DE)
Schaltungselement mit einer ersten Schicht aus einem elektrisch isolierenden Substratmaterial, Verfahren zur Herstellung eines Schaltungselementes, Bispyridinium-Verbindungen sowie deren Verwendung in Schaltungselementen
Anm.: Infineon Technologies AG

Dear Dr. Preece,

First of all we would like to set the record straight. The fee you received from Infineon Technologies AG was 550 Euro which is almost twice of 600 DM.

There is no European patent application. We filed a German and a US patent application.

Since Infineon does have a contract signed by yourself on 4th April 2001, you are obliged to pass the Power of Attorney und the Assignment over to Infineon.

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We would like to point out to paragraph 3.2 of the above mentioned contract to you which paragraph reads as

"The inventors will support Infineon at Infineon's request in any procedure for filing for an intellectual property right or in any action to defend such intellectual property rights, this support shall include, but not be limited to giving the explanations or information required or appropriate signatures.
....".

Infineon Technologies AG thanks you for your cooperation and feels up to pay a remuneration which is fixed by Infineon if Infineon will achieve a special commercial value by this invention.

Sincerely yours,



Eric-Michael Dokter
Patentanwalt

C O N T R A C T

between

Dr. Markus Seitz
Peter Kreuderer Strasse 5
81245 Munich
and
Dr. Jon A Preece
Flat 4, 55 Anderton Park Road, Moseley
Birmingham B13 9DU
United Kingdom

- hereinafter "Inventors" -

and

Infineon Technologies AG
St.-Martin-Str. 53
81541 München

- hereinafter "Infineon" -

Preamble:

The inventors have jointly with the Infineon employee, Dr. Johannes R. Luyken, made the invention described below.

The inventors are prepared to sell their share in the invention to Infineon and to transfer and assign any and all rights as to such share in the invention to Infineon and Infineon is prepared to purchase such share in the invention and to have such rights transferred and assigned to Infineon.

The inventors and Infineon agree as follows:

1. Definitions

"Invention" shall mean such share in the invention "Highly integrated electrical memory with functional adapted bis-pyridinium layers" as described in Appendix to this Contract.

2. Sale and Transfer of Right and Title to the Invention

- 2.1 The inventors warrant to have full and unencumbered right and title to the Invention and neither in the Federal Republic of Germany nor in any other country to have applied for any statutory intellectual property right with regard to such Invention nor to have caused any third party to do so.
- 2.2 The inventors sell and transfer and assign to Infineon and Infineon purchases and agrees to have transferred and assigned to it the right and title to the Invention with all rights to exploit such Invention at its sole discretion and all obligations resulting therefrom.

3. Intellectual Property Rights

- 3.1 Infineon is entitled, but not obliged to file for any intellectual property rights regarding the Invention at its own costs and in its own name within Germany and any other countries. Any such intellectual property rights shall be in the sole property of Infineon and Infineon shall be entitled to exploit such rights for its sole benefit and at its sole discretion.

Furtheron Infineon is entitled at any time and in its sole discretion to withdraw or abstain from pursuing any filing procedure for any intellectual property rights in any country.

- 3.2 The inventors will support Infineon at Infineon's request in any procedure for filing for an intellectual property right or in any action to defend such intellectual property rights, this support shall include, but not be limited to giving the explanations or informations required or appropriate signatures. The inventors will be reimbursed by Infineon for any actual and reasonable costs incurred in connection with such support.

4. Innovations and Improvements

The inventors shall inform Infineon on any innovations or improvements being supplementary to the Invention and regarding which the inventors are or will be authorised to

dispose, without regard to the possibility of any intellectual property rights protection with regard to such innovations or improvements. The inventors will offer to sell such rights to Infineon at fair and reasonable conditions.

5. Consideration

- 5.1 In consideration for the transfer of the rights described above, Infineon will pay each of the two inventors

Euro 550,—
(in words: fivehundredandfifty Euro).

respectively within four (4) weeks from execution of this Contract.

- 5.2 The inventors will be responsible for any taxes payable as a consequence of this Contract.

6. Validity; Form

- 6.1 This Contract shall be valid with execution by both parties.
- 6.2 Any changes or amendments to this Contract shall be valid only if agreed to by both parties in writing. Any agreement to deviate from this requirement shall be in writing only.
- 6.3 For this Contract the law of the Federal Republic of Germany shall be applicable without reference to any other laws.
- 6.4 The courts of Munich shall have jurisdiction for any dispute arising out of or in connection with this Contract.

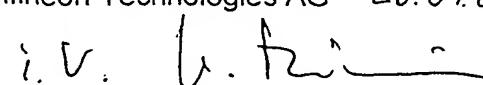
Munich, 12.4.01

Dr. Markus Seitz



Munich,

Infineon Technologies AG 26.04.01



I.U. Ebeling

Prof. Dr. K. J. Ebeling

Birmingham,

Jon Preece

Jon Preece 4/4/11